



## APPENDIX NOTES

**Note 1. Evidence with respect to Petitioner's business and business methods::** T. 217, 224, 227 and 802 and 1286, 245, 248 and 781, 252, 257, 259, 260, 264, 267, 366, 435, 468, 489, 610, 859, and Exhibits 1 to 100, see Index of Exhibits in Vol. V of Record for reference to Transcript.

**Note 2. Evidence with respect to Respondent's business and business methods:** T. 276, and 315 and 889 and 925, 320, 333, 340, 344 and 347, 934, 938, 944, 949, and Exhibits 200, 201, 203-289, inclusive, 292-294, 298, 307-317, 500-536, 539-558, 561-568, 575-606, 615-620, 2022-2026, 2030, see Index of Exhibits in Vol. V of Record for reference to Transcript.

**Note 3: Consumer witnesses (137).**

**(a) Those who had used Petitioner's product prior to advent of competition (129):** T. 262, 262, 289, 290, 361, 362, 381, 383, 385, 386, 388, 391, 412, 416, 417, 419, 431, 438, 446, 447, 460, 461, 464, 466, 482, 487, 490, 491, 505, 517, 518, 519, 532, 533, 534, 543, 546, 548, 551, 552, 568, 592, 601, 605, 606, 619, 624, 627, 637, 639, 640, 641, 657, 667, 671, 674, 680, 689, 693, 694, 696, 713, 729, 730, 745, 753, 766, 776, 777, 818, 819, 821, 825, 826, 827, 828, 831, 836, 837, 840, 844, 844, 845, 847, 854, 857, 860, 861, 862, 866, 868, 873, 880, 882, 883, 884, 885, 887, 888, 1032, 1034, 1045, 1053, 1065, 1067, 1074, 1077, 1089, 1109, 1112, 1114, 1129, 1134, 1137, 1141, 1145, 1148, 1151, 1153, 1155, 1158, 1163, 1169, 1178, 1181, 1193, 1195, 1198, 1209 and 1215.

(b) Consumer witnesses who had not heard of or used Petitioner's product (8): T. 290, 525, 867, 869, 869, 1040, 1117, 1172.

(c) Consumer witnesses who knew that "Raisin-BRAN" was a product of Skinner Manufacturing Company (46): T. 263, 361, 365, 386, 389, 391, 413, 421, 432, 438, 448, 463, 464, 467, 489, 492, 519, 532, 533, 534, 548, 551-552, 553, 583, 609, 619, 624, 641, 658, 668, 672, 674, 693, 713, 714, 717, 729, 753, 776, 819, 833, 846, 848, 886, 1054, 1110, and 1119.

(d) Consumers who testified there was only one source of product prior to April, 1942, though they did not know name of such source (13): T. 262, 373, 425, 430, 461, 482, 489, 520, 689, 718, 826, 1172.

(e) Consumers who identified Petitioner's package as only one they had been accustomed to purchase (50): T. 262, 262, 361, 362, 386, 388, 391, 431-432, 438, 448, 464, 467, 482, 490, 491, 492, 518, 518-519, 519, 532, 533, 534, 548, 553, 568, 593, 601, 605, 606, 619, 624, 640, 642, 649, 667, 671, 674, 689, 693, 713-716, 729, 776, 820, 822, 828, 874, 1110, 1112, and 1129.

(f) All of those witnesses listed in paragraph (e) above knew that Skinner was the distributor, except (5): T. 482, 689, 776-777, 874, 1130.

(g) Consumer witnesses who testified that when they wished Petitioner's product they asked for "Raisin-BRAN" (21): T. 363, 386, 389, 392, 464, 467, 482, 490, 534, 535, 596, 602-604, 606, 621, 639, 641, 667, 671, 828, 1055, and 1112.

(h) **Consumer witnesses who mistook Respondent's package for Petitioner's (9):** T. 681, 693, 694, 697, 714, 718, 730, 733, 755, 766, and 1162.

(i) **Consumers who testified that mark "Raisin Bran" meant Petitioner's product (24):** 365, 394, 414, 465, 490-491, 594, 601, 608, 615, 617, 621, 668, 674, 700, 715-716, 729, 819, 821, 875, 1055, 1076-1077, 1110-1111, 1149, 1171-1172, 1218.

**Note 4. Retail grocer witnesses (97):**

(a) **Retail grocer witnesses who had personal service and delivery (54):** T. 367, 370, 375, 378, 405, 409, 424, 429, 434, 436, 442, 449, 458, 474, 479, 485, 493, 498, 500, 507, 525, 527, 535, 539, 565, 566, 572, 579, 584, 634, 643, 660, 669, 692, 695, 698, 737, 740, 746, 756, 759, 769, 773, 823, 832, 834, 838, 876, 1047, 1164, 1186, 1190, 1200, and 1205.

(b) **Retail grocer witnesses who had exclusively self-service stores (30):** T. 451, 497, 509, 520, 554, 580, 645, 650, 652, 683, 699, 702, 707, 829, 842, 851, 1036, 1038, 1040, 1051, 1059, 1069, 1072, 1093, 1099, 1120, 1124, 1131, 1218, and 1221.

(c) **Retail grocers whose testimony did not indicate the type of their service (12):** T. 411, 558, 576, 597, 614, 631, 691, 734, 749, 849, 863, and 871.

(d) **Retail grocers who had never heard of Petitioner's product (3):** T. 864, 865, and 866.

(e) **Retail grocers who knew source of Petitioner's product (87):** T. 368, 371, 375, 380, 406, 409, 412, 427, 431, 434, 436, 445, 450, 452, 458, 475, 479, 481, 487, 494, 498,

499, 502, 508, 510, 521, 526, 528, 540, 555, 559, 565, 568, 574, 577, 580, 586, 598, 614, 622, 626, 632, 635, 644, 646, 651, 653, 661, 670, 691, 692, 695, 698, 700, 702-703, 708, 725, 740, 741, 747, 756, 769, 829, 835, 839, 842, 850, 852, 864, 876, 1039, 1048, 1052, 1059, 1070, 1073, 1081, 1094, 1102, 1120, 1124, 1133, 1189, 1204, 1220, and 1223.

(f) Retail grocers under class (a) above, who testified that before the advent of the Post and Kellogg competing products, their customers called for Petitioner's product under the trade name "**Raisin-BRAN**", standing alone (41): T. 368, 377, 430, 435, 437, 480, 487, 493, 498, 499, 508, 511, 521, 526, 528, 539, 559, 576, 582, 586, 614, 632, 636-637, 646, 652, 654, 661, 669, 685, 692, 698, 737, 741, 746, 749, 756, 769, 774, 833, 843, and 1133.

(g) Retail grocers under class (f) above, who testified that when their customers asked for just "**Raisin-BRAN**", they desired Petitioner's product (26): T. 368, 377, 430, 437, 480, 493, 498, 521, 526, 539, 576, 582, 586, 614, 632, 637, 646, 669, 685, 692, 737, 746, 769, 774, 833, and 1133.

(h) Retail grocers under class (a) above who testified that after the advent of the Post and Kellogg products their customers, when ordering the Petitioner's product, called for just "**Raisin-BRAN**" (30): T. 371, 380, 406, 410, 430, 435, 437, 444, 493, 499, 501, 526, 528, 536, 540, 567-568, 574, 634, 670, 698, 737, 740-744, 772-773, 774, 835, 839, 1050, 1188, 1193, and 1203.

(i) Retail grocers who testified that the mark "**Raisin Bran**" meant Petitioner's product (46): T. 369, 371, 374, 377, 380-381, 405-408, 410, 414, 424, 430, 441,

444, 472, 492, 495, 495, and 497, 499, 558, 560, 580, 582-83, 598 and 600, 615-617, 635 and 637, 644, 646, 649, 661, 670, 698, 700, 701, 703, 708, 726, 738, 741, 769 and 772, 1097, 1097-1099, 1102-1103, 1123, 1143, 1204, 1220, 1223 and 1225.

**Note 5. Wholesale grocer witnesses (49):** T. 263, 288, 356, 371, 396, 401, 422, 432, 439, 453, 456, 471, 473, 477, 483, 495, 495, 503, 512, 529, 541, 560, 562, 570, 578, 583, 586, 618, 628, 648, 654, 664, 675, 686, 701, 725, 727, 735, 761, 856, 870, 872, 878, 1024, 1029, 1056, 1080, 1141 and 1164.

(a) Of the above, the following did a joint wholesale and retail business: T. 495 and 1080.

(b) Of the above, all but the following knew the source of origin of Petitioner's product (4): T. 453, 477, 583 and 872.

(c) The following wholesale grocers testified that before the advent of the Post and Kellogg competing products, the term "Raisin-BRAN" meant Petitioner's product in the wholesale and retail trade (40): T. 264, 289, 357, 373, 398, 402, 423-424, 433, 441, 454, 458, 471-472, 473, 477, 484, 495, 504, 514, 530, 543, 561, 562, 572, 578-579, 587-588, 619, 629, 648, 656, 665, 676, 701, 726, 728, 871, 879, 1026-1027, 1030, 1144, and 1165.

**Note 6.** Prior to its adoption by the Petitioner in June, 1925, the term "Raisin-BRAN" had never been applied to any food product on the American market.

(a) Consumer witnesses who testified that name had not been applied to any other breakfast food: T. 262, 363,

392, 461, 482, 518, 520, 534, 621, 624, 640, 659, 667, 689, 718, 826 and 1172.

(b) **Retail grocers who so testified:** T. 373, 425 and 430.

(c) **There was no evidence that the name had been applied to any other food product prior to 1925.**

The Trial Court found that prior to April, 1942, there was no prepared breakfast food product on the American food market, other than Appellant's product, designated as "Raisin-BRAN", or in approximately similar fashion (F. 6, T. 143); but the Court refused the request of the Appellant (Par. I, T. 178) to find that at the time the Appellant adopted the term "Raisin-BRAN" for use upon its aforesaid product, said term, standing alone, was not in use as a designating term *for any food product* (Par. I, T. 181), and predicated its refusal upon the following: "The evidence in the case did not negative the possibility that it might have been employed alone in designating some other type of food. The most that can be said is that there is no evidence of any such employment \* \* \*" (Par. I, T. 181). In making this Finding, the Court apparently overlooked the uncontradicted testimony of consumers and retail grocers who testified positively that prior to April, 1942, they knew of *no food product* on the American market bearing the name "Raisin-BRAN" other than Appellant's product (see notes, 12j, k, l, m, page 135 *infra*), or if the Court did not overlook that testimony, the Court erred in its Conclusion of Law as to what is necessary to prove a negative. A negative, from its nature, usually admits of no more than approximate

proof, and evidence which renders the negative probable is sufficient proof of the negative in the absence of positive proof to the contrary. 32 C. J. S., Sec. 1025, p. 1062; *Leonard v. St. Joe Lead Co.*, 8th C. C. A., 1935, 75 F. 2d 390; *Southern Rwy. Co. v. Stewart*, 8th C. C. A., 1941, 119 F. 2d 85; *Majestic Securities Corp. v. Collector of Internal Revenue*, 8th C. C. A., 1941, 120 F. 2d 12; *Owen v. Carmichael's Auto Co.*, (Cal., 1931), 2 P. 2d 580.

**Note 7.** The Petitioner's attempt to register the trade-mark under the 1905 Trade Mark Act and its subsequent registration under the 1920 Trade Mark Act did not preclude the term "Raisin-BRAN" from acquiring a secondary meaning.

In the Lower Court, the Respondent insisted that the Petitioner admitted that the term "Raisin-BRAN" was so descriptive that it could not acquire a secondary meaning because when the Petitioner first tried to register its mark under the Trade Mark Act of 1905, such registration was denied on April 9, 1926, on the ground that "Raisin-BRAN, is merely the commercial name of applicant's goods", and the applicant did not appeal from such decision, but shortly thereafter registered the mark under the Trade Mark Act of 1920 (T. 294).

The Trial Court paid no heed to this particular objection, and it is apparent that the objection was of no force or effect, for as shown in the case of *Armstrong Paint & Varnish Co. v. Nu-Enamel Corp.*, 305 U. S. 315, this Court has held that the registration under the 1920 Act did not preclude the acquisition of a secondary meaning. Surely the fact that the term was used as a commercial name for the product did not preclude the Pe-



tioner from claiming it as a trade-mark nor prevent the term from thereafter acquiring a secondary meaning under the method employed by the Petitioner to create such secondary meaning. At the time that the registration was sought under the 1905 Trade Mark Act, the question whether or not the term had acquired a secondary meaning was not at issue, and those proceedings in the Patent Office were not res judicata of the proceedings here. *Popular Mechanics Co. v. Fawcett Publications, Inc.*, 1 F. S. 292, 294; *Trappey v. McIlhenny Co.*, 281 F. 23, cert. denied, 43 S. Ct. 94, 260 U. S. 733; *Gaidry v. McIlhenny Co.*, 253 F. 613; *Bisceglia Bros. v. Fruit Industries, Ltd.*, 20 F. S. 564; *In Re American Cyanide & Chemical Corp.*, 99 F. 2d 964.

Note 8. Petitioner's trade-mark use on its packages.

**Raisin-**  
TRADE MARK BRAND NAME  
 REG. U. S. PAT OFF AND STATES  
**BRAN**  
TRADE MARK BRAND NAME  
 OF THIS PRODUCT WHICH IS

(From Ptf. Ex. 9)

Note 9. Early design for label and early proposed designation for Respondent's product.

**40% R R R A N  
WITH  
RAISINS  
F L A K E S**

(Exhibit 209)

Note 10. Steps in development of label for Respondent's product.

*Kellogg's*  
**RAISIN**  
**40% BRAN**  
**FLAKES**

FLAKED WHEAT WITH MORE BRAN  

---

AND LESS STARCH THAN WHOLE WHEAT  

---

WITH SUGAR, SALT AND MALT FLAVORING  

---

NET WEIGHT 8 OUNCES

MADE BY KELLOGG CO., BATTLE CREEK, MICH.

(Exhibit 208)

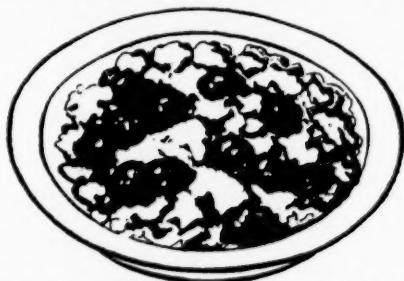
**RAISIN**  
**40% BRAN**  
**FLAKES**

(Exhibit 293)

**RAISIN**  
**40% BRAN**  
**FLAKES**

(Exhibit 204)

**FLAKED WHEAT WITH MORE BRAN  
AND LESS STARCH THAN WHOLE WHEAT  
WITH SUGAR, SALT AND MALT FLAVORING**



**NET WEIGHT 8 OUNCES  
MADE BY KELLOGG CO., BATTLE CREEK, MICH.**

(Exhibit 209)

**WITH OTHER PARTS OF WHEAT, RAISINS,  
AND SUGAR, SALT AND MALT FLAVORING**



**NET WEIGHT**

**10 OUNCES**

**MADE BY KELLOGG CO., BATTLE CREEK, MICH.**

(Exhibit 210)

*Kellogg's*

**RAISIN**

**40% BRAN**

**FLAKES**

WITH OTHER PARTS OF WHEAT, RAISINS,  
SUGAR, SALT AND MALT FLAVORING



NET WEIGHT

10 OUNCES

*Cereal with Fruit*

MADE BY KELLOGG CO., BATTLE CREEK, MICH.

(Exhibit 203)

**Raisin-**  
TRADE MARK BRAND NAME  
 REG. U. S. PAT. OFF. AND STATES  
**BRAN**  
TRADE MARK BRAND NAME  
 OF THIS PRODUCT WHICH IS!

**Whole Wheat Flakes with Raisins  
 Bran and Salt Added**



**Cereal AND Fruit**

*Toasted*

COPY. 1940. EST. L. S.

An exclusive product distributed by SKINNER MANUFACTURING CO., Omaha, Neb.

(Exhibit 9)

**Note 11.** The testimony of witnesses who said they were not confused or would not be confused: T. 388, 390, 396, 412, 419, 668, 692, 695, 699, 700, 720, 771, 778, 846, 873, 874, 877, 886, 1026, 1030, 1033, 1035, 1037, 1039, 1041, 1043, 1046, 1049, 1052, 1066, 1066, 1121, 1125, 1135, 1139, 1172, 1174, 1176, 1192, 1194, 1197, 1199, 1202, 1216.

**Note 12.** Answers to questions as to meaning of term Raisin Bran.

(a) Answers of consumers and retailers to question, "What does raisin bran mean to you?" T. 376, 384, 385, 390, 403-404, 405 and 408, 413, 416, 418, 423-424, 425, 429-430, 444, 446, 449, 456, 459, 461, 482, 492, 495, 498, 571, 577, 581, 586, 633, 638, 641, 642, 653, 661-662, 668, 693, 695, 699, 757, 761, 768, 821, 824, 826, 832, 833, 839, 843, 846, 847, 852, 855, 858, 863, 884, 887, 1030, 1035, 1039, 1041, 1046, 1049, 1055, 1070, 1072, 1075, 1078, 1091, 1095, 1100, 1111, 1113, 1115, 1119, 1121, 1125, 1132, 1135, 1138, 1143, 1146, 1149, 1151, 1152, 1159, 1176, 1182, 1187, 1191, 1194, 1197, 1199, 1201, 1206, 1216, 1219, 1222.

(b) Witnesses listed in (a) who gave their evidence with the Kellogg and General Foods competing products in mind: T. 385, 413-414, 423, 425, 429, 444, 455-456, 459, 461, 481-482, 571, 577, 581-582, 586, 633, 635, 638, 653, 692-693, 695-696, 699, 757, 761, 768, 821, 824, 826, 833, 839, 843, 847-848, 852, 858, 863, 884, 887, 889, 1026, 1030, 1039, 1041, 1046, 1049, 1072, 1075, 1078, 1091, 1095, 1100, 1111, 1115, 1119, 1121, 1123, 1125, 1132, 1135, 1138, 1143, 1146, 1149, 1151, 1152, 1159, 1187, 1191, 1194, 1199, 1201, 1206, 1216.

(c) Witness listed in (a) who testified that before advent of General Foods and Kellogg competing prod-



ucts, "Raisin Bran" mean petitioner's product: T. 376-377, 405 and 408, 410, 413-414, 423-424, 429-430, 444, 492, 499, 582-583, 594, 598-600, 635, 644, 661-662, 668, 674-675, 698-699, 700, 701, 729, 738, 741, 769 and 772, 819-821, 875, 1076-1077, 1095 and 1097, 1102-1103, 1143-1144, 1204-1205, 1216-1218, 1218-1220, 1222-1223.

(d) Witnesses listed in (a) who answered leading and suggestive questions: T. 390, 446, 495, 498, 571, 638, 668, 768, 826, 833, 1072, 1075, 1095, 1111, 1113, 1132.

(e) Witnesses listed in (a) who had practically no acquaintance with Petitioner's product: T. 384, 416, 418, 492, 832, 855, 1034-1035, 1046, 1072-1073, 1149, 1152, 1159, 1176, 1182, 1197.

(f) Witnesses listed in (a) who were asked for dictionary definitions: T. 393, 403, 571, 577, 581, 586, 633, 635, 638, 641, 642, 653, 661-662, 668, 693, 695, 699, 757, 761, 768, 821, 824, 826, 832, 833, 839, 843, 846, 847, 852, 855, 858, 863, 884, 887, 889, 1039, 1041, 1046, 1070, 1072, 1075, 1078, 1091, 1095, 1100, 1111, 1113, 1115, 1119, 1121, 1125, 1132, 1135, 1138, 1143, 1146, 1149, 1151, 1152, 1159, 1176, 1182, 1187, 1191, 1194, 1197, 1199, 1201, 1206, 1216, 1219, 1222.

(g) Consumer and retailer witnesses who answered that "raisin bran" does not mean a particular producer:

Consumers: 413, 416, 461, 653, 889, 1152, 1182, 1194, 1216-1217.

Retail Grocers: 430, 444, 699, 756-757, 824, 1187, 1192, 1201-1202, 1206-1207, 1218-1220, 1221-1223.

(h) Witnesses listed in (g) whose testimony shows

that before competition they understood "Raisin Bran" meant the Petitioner's product:

Consumers: 413, 653, 1216-1217.

Retailers: 699, 756-757, 1218-1220, 1221-1223. (See also 430, 444, 1206-1207.)

(i) Witnesses listed in (g) who had competing products in mind when testifying:

Consumers: T. 461, 653, 889, 1152, 1182, 1194, 1216-1217.

Retailers: T. 756-757, 824, 1187, 1192, 1201-1202, 1206-1207, 1218-1220, 1221-1223.

(j) Witnesses who testified that before Respondents put their competing products on the market, the term "raisin bran", standing alone, had not been applied to any food product. T. 262, 363, 392, 461, 482, 489, 518, 520, 534, 621, 624, 640, 659, 667, 689, 718, 821, 826, 1172, 373, 425, 430.

(k) Witnesses listed in (a) above who testified that before Respondents put their competing products on the market there was no product other than Petitioner's known as "raisin bran". T. 362, 377, 449, 640, 642, 1112, 1126, 461, 654, 663, 834, 852, 1093, 1098, 1104, 1123, 1126, 1135, 1170, 1174, 1180, 1193, 1195, 1219.

(l) Witnesses listed in (a) above who testified that there was no such thing as the bran of a raisin. T. 849, 852.

(m) Witnesses listed in (a) above who testified that "raisin bran" did not signify any particular formula. T. 413, 416, 418, 423, 444, 459, 461, 824, 843.

**Note 13. Retail grocer witnesses who said they didn't know of any confusion:** T. 426-427, 487, 556, 577, 617, 1030, 1037, 1039, 1041, 1049, 1052, 1066, 1072, 1101, 1121, 1125, 1187, 1202.

**Note 14. Section 240 (a) of Judicial Code:**

"Sec. 240. (a) In any case, civil or criminal, in a circuit court of appeals, or in the Court of Appeals of the District of Columbia, it shall be competent for the Supreme Court of the United States, upon the petition of any party thereto, whether Government or other litigant, to require by certiorari, either before or after a judgment of decree by such lower court, that the cause be certified to the Supreme Court for determination by it with the same power and authority, and with like effect, as if the case had been brought there by unrestricted writ of error or appeal."

**Note 15. Federal Rule of Civil Procedure 52:**

"**Rule 52. Finding by the Court. (a) Effect.** In all actions tried upon the facts without a jury, the court shall find the facts specially and state separately its conclusions of law thereon and direct the entry of the appropriate judgment; and in granting or refusing interlocutory injunctions the court shall similarly set forth the findings of fact and conclusions of law which constitute the grounds of its action. Requests for findings are not necessary "unless clearly erroneous, and due regard shall be given to the opportunity of the trial court to judge of its credibility of the witnesses. The findings of a master, to the extent that the court adopts them, shall be considered as the findings of the court."

**Note 16. Federal Rule of Civil Procedure 1:**

**"Rule 1. Scope of Rules.** These rules govern the procedure in the district courts of the United States in all suits of a civil nature whether cognizable as cases at law or in equity, with the exceptions stated in Rule 81. They shall be construed to secure the just, speedy, and inexpensive determination of every action."

**Note 17. c. 651, 48 Stat. 1064:**

**"Sec. 1. Rules in actions at law; Supreme Court authorized to make.** The Supreme Court of the United States shall have the power to prescribe, by general rules, for the district courts of the United States and for the courts of the District of Columbia, the forms of process, writs, pleadings, and motions, and the practice and procedure in civil actions at law. Said rules shall neither abridge, enlarge, nor modify the substantive rights of any litigant. They shall take effect six months after their promulgation, and thereafter all laws in conflict therewith shall be of no further force or effect.

**"Sec. 2. Union of equity and action at law rules; power of Supreme Court.** The court may at any time unite the general rules prescribed by it for cases in equity with those in actions at law so as to secure one form of civil action and procedure for both: Provided, however, That in such union of rules the right of trial by jury as at common law and declared by the seventh amendment to the Constitution shall be preserved to the parties inviolate. Such united rules shall not take effect until they shall have been reported to Congress by the Attorney General at the beginning of a regular session thereof and until after the close of such session."

**Note 18. Ten-year clause of 1905 Trade Mark Act:**

“Sec. 5. **Trade-marks which may be registered.** No mark by which the goods of the owner of the mark may be distinguished from other goods of the same class shall be refused registration as a trade-mark on account of the nature of such mark unless such mark—

“(a) Consists of or comprises immoral or scandalous matter.

“(b) Consists of or comprises the flag or coat of arms or other insignia of the United States or any simulation thereof, or of any State or municipality or of any foreign nation, or of any design or picture that has been or may hereafter be adopted by any fraternal society as its emblem, or of any name, distinguishing mark, character, emblem, colors, flag, or banner adopted by any institution, organization, club, or society which was incorporated in any State in the United States prior to the date of the adoption and use by the applicant: Provided, That said name, distinguishing mark, character, emblem, colors, flag, “or banner was adopted and publicity used by said institution, organization, club, or society prior to the date of adoption and use by the applicant: Provided, That trade-marks which are identical with a registered or known trade-mark owned and in use by another and appropriated to merchandise of the same descriptive properties, or which so nearly resemble a registered or known trade-mark owned and in use by another and appropriated to merchandise of the same descriptive properties as to be likely to cause confusion or mistake in the mind of the public or to deceive pur-

chasers shall not be registered: Provided, That no mark which consists merely in the name of an individual, form, corporation, or association not written, printed, impressed, or woven in some particular or distinctive manner, or in association with a portrait of the individual, or merely in words or devices which are descriptive of the goods with which they are used, or of the character or quality of such goods, or merely a geographical name or term, shall be registered under the terms of this subdivision of this chapter: Provided further, That no portrait of a living individual may be registered as a trade-mark except by the consent of such individual, evidenced by an instrument in writing, nor may the portrait of any deceased President of the United States be registered during the life of his widow, if any, except by the consent of the widow evidenced in such manner: And provided further, That nothing herein shall prevent the registration of any mark used by the applicant or his predecessors, or by those from whom title to the mark is derived, in commerce with foreign nations or among the several States or with Indian tribes which was in actual and exclusive use as a trade-mark of the applicant, or his predecessors from who he derived title, for ten years next preceding February 20, 1905: Provided "further, That nothing herein shall prevent the registration of a trade-mark otherwise registrable because of its being the name of the applicant or a portion thereof. And if any person or corporation shall have so registered a mark upon the ground of said use for ten years preceding February 20, 1905, as to certain articles or classes of articles to which said mark shall have been applied for said period, and shall have thereafter and subsequently

extended his business so as to include other articles not manufactured by said applicant for ten years next preceding February 20, 1905, nothing herein shall prevent the registration of said trade-mark in the additional classes to which said new additional articles manufactured by said person or corporation shall apply, after said trade-mark has been used on said article in interstate or foreign commerce or with the Indian tribes for at least one year provided another person or corporation has not adopted and used previously to its adoption and use by the proposed registrant, and for more than one year such trade-mark or one so similar as to be likely to deceive in such additional class or classes." Feb. 20, 1905, c. 592, Sec. 5, 33 Stat. 725; Mar. 2, 1907, c. 2573, Sec. 1, 34 Stat. 1251; Feb. 18, 1911, c. 113, 36 Stat. 918; Jan. 8, 1913, c. 7, 37 Stat. 649; Mar. 19, 1920, c. 104, Sec. 9, 41 Stat. 535; June 7, 1924, c. 341, 43 Stat. 647.

**Note 19. Section 16 of the 1905 Trade Mark Act:**

"Sec. 16. **Evidence of ownership; infringement, and damages therefor.** The registration of a trade-mark under the provisions of this sub-division of this chapter shall be prima facie evidence "of ownership. Any person who shall, without the consent of the owner thereof, reproduce, counterfeit, copy, or colorably imitate any such trade-mark and affix the same to merchandise of substantially the same descriptive properties as those set forth in the registration, or to labels, signs, prints, packages, wrappers, or receptacles intended to be used upon or in connection with the sale of merchandise of substantially the same descriptive properties as those set forth in such registration, and shall use, or shall have used,

such reproduction, counterfeit copy, or colorable imitation in commerce among the several States, or with a foreign nation, or with the Indian tribes, shall be liable to an action for damages therefor at the suit of the owner thereof; and whenever in any such action a verdict is rendered for the plaintiff, the court may enter judgment therein for any sum above the amount found by the verdict as the actual damages, according to the circumstances of the case, not exceeding three times the amount of such verdict, together with the costs." Feb. 20, 1905, c. 592, Sec. 16, 33 Stat. 728.

**Note 20. Section 17 of the 1905 Trade Mark Act:**

"Sec. 17. **Jurisdiction of suits.** The district and Territorial courts of the United States and the district court of the United States for the District of Columbia shall have original jurisdiction, and the circuit courts of appeal, of the United States and the United States Court of Appeals for the District of Columbia shall have appellate jurisdiction of all suits at law or in equity respecting trade-marks registered in accordance with the provisions of this subdivision of this chapter, arising thereunder, "without regard to the amount in controversy." Feb. 20, 1905, c. 592, Sec. 17, 33 Stat. 728; Mar. 3, 1911, c. 231, Sec. 291, 36 Stat. 1167; June 7, 1934, c. 426, 48 Stat. 926; June 25, 1936, c. 804, 49 Stat. 1921.

**Note 21. Section 6 of the 1920 Trade Mark Act:**

"Sec. 6. The provisions of Secs. 15, 17 to 27, inclusive, and 28 (as to class B marks only) of the 1905 Trade Mark Act, and the provisions of Sec. 2 of said Act, are made applicable to marks placed on the register pro-



vided for by Sec. 1 of this Act." Mar. 19, 1920, c. 104, Sec. 6, 41 Stat. 535.

**Note 22. Cases cited by Lower Courts and Respondent, classified and distinguished.**

(a) Cases which were decided prior to the time that the American and English Courts recognized that geographical, generic or descriptive words might acquire a secondary meaning;<sup>11</sup> or

(b) Cases in which the words sought to be appropriated were already in use in the language as designations for the particular products to which they were applied at the time the appropriation was sought, or were terms which were so completely descriptive of the product that to grant monopoly of them would deprive competitors of the ability to aptly describe their competing products;<sup>12</sup> or

(c) Cases in which the defendant was not seeking to use the exact term in such a manner as to be charged

11 *Canal Co. v. Clark*, 80 U. S. (13 Wall.) 311, 20 L. Ed. 581 (decided 1871); with like exceptions, see *Amoskeag Mfg. Co. v. Trainer*, 101 U. S. 51, 25 L. Ed. 993 (decided 1880); *Lawrence Mfg. Co. v. Tennessee Mfg. Co.*, 138 U. S. 537; 34 L. Ed. 997 (decided 1891); *Brown Chemical Co. v. Meyer*, 127 U. S. 540, 35 L. Ed. 247 (decided 1890); *Good Year's India Rubber Glove Mfg. Co. v. Goodyear India Rubber Co.*, 128 U. S. 592, 32 L. Ed. 535 (decided 1888); *Linoleum Mfg. Co. v. Nairn*, 7 Ch. Div. 834 (decided 1877).

12 "Toasted Corn Flakes," *Kellogg Toasted Corn Flakes Co. v. Quaker Oats Co.*, 235 F. 657; "Shredded Wheat," *Kellogg Co. v. National Biscuit Co.*, 305 U. S. 111; "Vistand," *Armstrong Mfg. Co. v. Ridge Tool Co.*, 132 F. 2d 158; "Mechanics," *Fawcett Publications v. Popular Mechanics Co.*, 80 F. 2d 194; "Food Center" (not strong case), *Houston v. Berde*, 2 N. W. 2d 9 (Minn.); "Jell-Well" applied to gelatin food, *Jell-Well Dessert Co. v. Jell-X-Cell Co.*, 22 F. 2d 522; "Computing" and "Standard" in names of corporations manufacturing scales, *Computing Scale Co. v. Standard Computing Scale Co.*, 118 F. 965; "Basser" as applied to a fish bait, *James Heddon's Sons v. Millsite Steel & Wire Co.*, 128 F. 2d 6; "Cerate," "Capsules," "Suppositories," "Tablets," "Laxatives," "Pencils (not used as trade-marks)," *Viavi Co. v. Vimedia Co.*, 245 F. 289; "Brake Block," *American Brake Shoe & Foundry Co. v. Alltex Products Corp.*, 117 F. 2d 983.

with using practically an identical term, but had made such changes as were possible under the circumstances to obviate the conclusion that there was an intentional infringement, as for instance where "Coca-Quinine" was held not infringed by "Quin-Coca";<sup>13</sup> or cases in which the words or terms were so dissimilar as to preclude the charge of infringement;<sup>14</sup> or

(d) Cases in which the claimant had not relied upon the descriptive, generic or geographical words to indicate the source of origin, but had used his own name or some other name as a part of said mark and as a means of indicating the source of origin;<sup>15</sup> or

- 13 *W. R. Warner & Co. v. Eli Lilly and Co.*, 265 U. S. 526, 68 L. Ed. 1161; see also "Roof-Leak," held not infringed by the name "Never Leak," *Sears, Roebuck & Co. v. Elliott Varnish Co.*, 232 F. 588; "Food Breakers," held not infringed by "Combination Cake Breakers, Pie Cutter and Server," *Coradon Co. v. Schneider*, 47 F. S. 735.
- 14 "Ripplette"-"Krinklette," *Bliss, Fabyan & Co. v. Aileen Mills, Inc.*, 25 F. 2d 370; "Steel Shod"-"Steel Clad," *Brennan v. Emery-Bird-Trayer Dry Goods Co.*, 108 F. 624; "Specs"-"Goggles," *Crindlebaugh v. Rudolph*, 131 F. 2d 795; (See (g) also); "Tuberoze"-"True Smoke," *P. Lorillard Co. v. Peper*, 86 F. 956; "Grape Nuts"-"Grain Hearts," *Postum Cereal Co., Ltd. v. American Health Food Co.*, 119 F. 848; "Rex" on glass pharmaceutical bottles held not infringed by "Pyrex" on glass cooking utensils where only competing article was babies' milk bottle, *Walgreen Stores v. Obeur-Nestor Glass Co.*, 113 F. 2d 956; "Wornova"-"Slipova," *Wornova Mfg. Co. v. McCawley & Co.*, 11 F. 2d 465; "Old Country"-"Our Country," *Allen B. Wrisley Co. v. Iowa Soap Co.*, 122 F. 796.
- 15 "Brooten's Kelp Ore," *Brooten v. Oregon Kelp Ore Products Co.*, 24 F. 2d 406; "Samaritan Nerveine," *Richmond Remedies Co. v. Dr. Miles Medical Co.*, 16 F. 2d 598; "Sanias (also Kellogg's Toasted Corn Flakes," *Kellogg Toasted Corn Flakes Co. v. Quaker Oats Co.*, 235 F. 657; "DuPont Cellophane," *DuPont Cellophane Co., Inc. v. Waxed Products Corp.*, 85 F. 2d 75; See also "Hunyadi Janos," *Sarlchner v. Wagner*, 316 U. S. 375, 54 L. Ed. 525; "Horlick's Malted Milk," *Horlick's Malted Milk v. Summerskill*, 85 L. J. R. 338; "Fels Naphtha," *Fels v. Christopher-Thomas & Bros.*, 21 R. P. C. 85; "W. H. Bull's Herbs & Iron," *Spicer v. W. H. Bull Medicine Co.*, 49 F. 2d 980; "Krank's Lather Kreem," *A. J. Krank Mfg. Co. v. Pabst*, 277 F. 15; "American Brakeblok," *American Brake Shoe & Foundry Co. v. Altter Products Corp.*, 117 F. 2d 983; *Cellular Clothing Co. Ltd. v. Maxton & Murray*, L. R. (1899) A. C. 326, 80 L. T. R., N. S. 808, was an appeal from the Scottish High Court of Justice, the decision for which is found in 35 Sc. L. R. 869. In the Scottish Reports it appears that the claimants had used the word "Aertex" as its trade-mark and had also designated the product "Kershaw's Cellular Cloth," the word "Kershaw's" being the name used to identify the source of origin; "Parson's Oatmeal," *Parsons Bros. v. John Gillespie*, 15 R. P. C. 57.

(e) Cases in which the claimant when it first placed its product upon the market, and for a number of years thereafter, did not use as a trade-mark the descriptive or generic words which it later claimed had acquired a secondary meaning, but first used such words as purely descriptive of the product and placed distinctive trade marks on the packages to indicate the source of origin;<sup>16</sup> or

(f) Cases in which the plaintiff was claiming a secondary meaning but where the evidence showed that plaintiff had not had the exclusive use of the term claimed, but the term was in common use in the compet-

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16 *Kellogg Co. v. National Biscuit Co.*, 305 U. S. 111; *DuPont Cellophane Co. v. Waxed Products Corp.*, 85 F. 2d 75; Claimant depended on a white horse as trade-mark, *Jamieson & Co. v. Jamieson*, 15 R. P. C. 169; Claimant had trade-mark represented by picture of a pig in natural walking position, head down, with words "Pig Sandwich" extending from shoulder to hind leg. Respondent relied on trade-mark consisting of picture of a pig standing erect with a checked cap on head, white apron fastened around neck, checked tie around neck, pig holding a knife as a waiter in front hoofs, with a sandwich thereon, and the word "Dixiepig" immediately under the waiter, *Dixiepig Corporation v. Pig Stand Co.*, (Civ. App., Tex. 1930, 31 S. W. 2d 325; "Mirrolike" applied to polish, claimant's mark surrounded by diagram or ornamental scroll, *Mirrolike Mfg. Co. v. DeVoe & Reynolds Co., Inc.*, 3 F. 2d 847; *S. Chivers & Sons v. S. Chivers & Co.*, 17 R. P. C. 421, in which case the dispute related to the use of the surname "Chivers" on jams and jellies. The complainant in the case used a gold seal for its trade-mark and did not rely on the name "Chivers" for a trade-mark, and the respondent in the case used a pictorial design with the word "Salisbury" as its trade-mark; *Parsons Bros. v. John Gillespie*, 15 R. P. C. 57, in which case a pictorial trade-mark had been used to indicate source of origin; *Steem-Electric Corp. v. Herzfeld Phillipson Co.*, 118 F. 2d 122, in which case a pictorial trade-mark had been used with a picture of a flatiron from which a cloud of steam was emanating, with a bolt of lightning coming from the cloud to the iron.

itive trade or generic name for the product to which the plaintiff sought to apply the mark;<sup>17</sup> or

(g) Cases in which the decision did not turn upon the establishment of a secondary meaning or in which the plaintiff's right or claim was predicated upon a claim of a technical trade-mark right and not upon a secondary meaning;<sup>18</sup> or

- 17 "Steem-Electric" (steam electric), *Steem-Electric Corp. v. Herzfeld Philipson Co.*, 118 F. 2d 122; "Dridip" (dry dip), *Ungles-Hoggette Mfg. Co. v. Farmers' Hog & Cattle Powder Co.*, 232 F. 116; "Nervine," *Richmond Remedies Co. v. Dr. Miles Medical Co.*, 16 F. 2d 598; "Corn Flakes," *Kellogg Toasted Corn Flakes Co. v. Quaker Oats Co.*, 235 F. 657; "Oaties" (diminutive "ies" not being exclusive in the defendant), *Quaker Oats Co. v. General Mills Co.*, 134 F. 2d 429; to like exception are "Hunyadi Water," *Saalechner v. Wagner* 316 U. S. 375, 54 L. Ed. 525; "Imperial Whiskey," *Hiram Walker & Sons v. Penn-Maryland Corp.*, 79 F. 2d 836; "Mirrorlike" applied to polish, *Mirrorlike Mfg. Co. v. DeVoe & Reynolds Co., Inc.*, 3 F. 2d 847 (See (e) also); "Wire Glass" as a name for glass in which wire is enmeshed, *Wire Glass Co. v. Continuous Glass Co.*, 79 N. J. E. 277, 81 At. 374; "Cellular Cloth," *Cellular Clothing Co., Ltd., v. Maxton & Murray*, 35 Sc. L. R. 869.
- 18 "No-D-Ka," *No-D-Ka Dentrifice Co. v. S. S. Kresge Co.*, 24 F. 2d 726; The claimant asserted that "No-D-Ka" was a technical trade-mark and entitled to the protection of registration under the 1905 Trade-Mark Act, but not under the ten-year clause thereof, and the Court held that the term was not a technical trade-mark, and no secondary meaning having been established, the decision was adverse to the claimant; "Elgin Watch," *Elgin National Watch Co. v. Illinois Watch Co.*, 179 U. S. 665, 21 S. Ct. 270, 45 L. Ed. 365 (1900); Subsequent to the foregoing decision, the right of the plaintiff to protection in the name "Elgin" because of the secondary meaning which the name had acquired was upheld by the Federal Courts, *Elgin National Watch Co. v. Loveland*, 132 F. 41, C. C. Ia. 1904; "Ruberoid," *Standard Paint Co. v. Trinidad Asphalt Mfg. Co.*, 220 U. S. 446, 55 L. Ed. 536; *Beckwith v. Commissioner of Patents*, 252 U. S. 538, 64 E. Ed. 705; "Stabrite" for polish, secondary meaning not involved, patent office registration only, *In re Swan & Finch Co.*, 259 F. 991; "Boiler Meter" for meter which would measure steam from boiler, secondary meaning not involved, *Ex Parte Bailey Meter Co.*, 487 O. G. 675, 36 U. S. P. Q. 294; Patent Office Registration, *Ex Parte Railley Corp.*, 42 U. S. P. Q. 472; Patent Office registration, *Ex Parte Bardons & Oliver Inc.*, 42 U. S. P. Q. 632; "Bowlmill" as trade-mark for patented grinding device, no secondary meaning involved, *Ex Parte Combustion Engineering Co.*, 43 U. S. P. Q. 191; "Speed Wagon" as applied to trucks, Patent Office registration, no secondary meaning involved, *Ex Parte Reo Motor Car Co.*, 341 O. G. 4, 16 F. 2d 349; "Malto-Dextrine," trade-mark registration, no secondary meaning involved, *In re Hartog*, 49 U. S. P. Q. 121; "Ne Line" for hosiery, *In re Archer Hosiery Mills*, 135 F. 2d 239; "Arch Rest" (held not descriptive), *In re Irving Drew*, 297 F. 889; "Al-Kol" for alcohol, *American Druggists' Syndicate v. United States Industrial Alcohol Co.*, 2 F. 2d 942; "Prun-O-Wheat," *W. E. Long v. U. S. Bakery*, 20 U. S. P. Q. 520.

(h) Cases in which the product to which the term was applied were patented, so that it was held that the designation given to the patented article passed to the public domain with the expiration of the patent, and there were no special circumstances warranting an exception to such general rule;<sup>19</sup> or

(i) Cases in which a trade-mark or trade name so aptly described competing products that the public on its own motion and without any effort or blame on the part of competitors adopted the term as the name for the product, whether sold by the original user or his competitors, and thus made a free word of the trade-mark;<sup>20</sup> or

(j) Cases in which numbers, colors, the use of unpatented articles, or pictures, not trade-marks or trade names, were involved.<sup>21</sup>

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19 "Shredded Wheat", *Kellogg Co. v. National Biscuit Co.*, 305 U. S. 111, 83 L. Ed. 73; "Cellophane", *DuPont Cellophane Co. Inc. v. Waxed Products Corp.*, 85 F. 2d 75; see also "*Steam-Electric Corp. v. Herzfeld Phillipson Co.*", 118 F. 2d 122; "Linoleum", *Linoleum Mfg. Co. v. Nairn*, 7 Ch. Div. 834; *Singer Mfg. Co. v. June Mfg. Co.*, 163 U. S. 169, 16 S. Ct. 1002, 41 L. Ed. 118; *Centaur v. Heinsfurter*, 84 F. 955; "Magic Drill Chuck", *Collis Co. v. Consolidated Machine Tool Corp.*, 41 F. 2d 641; "Specs", *Cridlebaugh v. Rudolph*, 131 F. 795; "Wire Glass", *Wire Glass Co. v. Continuous Glass Co.*, 79 N. J. E. 277, 18 At. 374.

20 *Dry Ice Corporation v. Louisiana Dry Ice Corporation*, 54 F. 2d 882.

21 Color—*Diamond Match Co. v. Saginaw Match Co.*, 142 F. 727; Article manufactured, *Zithers—Flagg Mfg. Co. v. Holway*, 178 Mass. 83, 59 N. E. 667; Numbers and letters for grades and types—*Matthews Conveyor Co. v. Palmer-Bee Co.*, 135 F. 2d 73; Color and packaging of box of candy—*Morse v. Towney*; 256 F. 935; Type of overall—*J. C. Penney Co. v. H. D. Lee Mercantile Co.*, 120 F. 949; Unpatented use of unpainted aluminum and unpatented form of construction for a mechanical implement—*Pope Automatic Merchandising Co. v. M'Crum-Howell Co.*, 191 F. 979; Type of table—*Zangerle & Peterson Co. v. Venice Furniture Novelty Mfg. Co.*, 133 F. 2d 266.

